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James L. Cordek
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In re Application of :
WORRALL *et al* :
U.S. Application No.: 10/5²1,566¹⁴⁵ (2) :
PCT No.: PCT/US2003/022844 :
Int. Filing Date: 22 July 2003 :
Priority Date: 22 July 2002 :
Attorney Docket No.: SP-1307-PCT US :
For: FOOD COATING COMPOSITION AND :
METHOD OF MAKING SAME :

DECISION

This decision is in response to applicants' petition under 37 CFR 1.47(a) filed 15 August 2005.

BACKGROUND

On 16 June 2005, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge fee was required. Applicants were given two months to respond with extensions of time available.

On 15 August 2005, applicants filed a response which was accompanied by, *inter alia*, the subject petition; the \$130.00 surcharge fee; a declaration signed by two of the three joint inventors; a statement of facts; copies of letters sent to the nonsigning inventor and Express Mail receipts; and authorization to charge the petition fee and any additional fee required to Deposit Account No. 50-0421.

DISCUSSION

Petitioners claim that Thomas R. Katen refuses to join the application and have filed the subject petition as a response to the Form PCT/DO/EO/905 mailed 16 June 2005.

A petition under 37 CFR 1.47(a) requires: (1) the petition fee; (2) factual proof that the missing joint inventor cannot be located or refuses to cooperate; (3) a statement of the last known address of the nonsigning joint inventor; (4) and an oath or declaration executed by the signing joint inventor on their behalf and on behalf of the nonsigning joint inventor.

Concerning item (1), the fee for a petition under 37 CFR 1.47 changed to \$200.00

on 08 December 2004. This fee has been charged to Deposit Account No. 50-0421 as authorized.

With regards to item (3), the last known address of co-inventor Thomas R. Katen is listed as:

3875 Wildshire East Road
Wildshire, Ohio 45898

Concerning item (4), the 37 CFR 1.47(a) applicant submitted a declaration signed by two of the three co-inventors on behalf of themselves and the nonsigning joint inventor. This declaration meets the requirements of section 409.03(a) and is in compliance with 37 CFR 1.497(a) and (b).

Items (1), (3) and (4) of 37 CFR 1.47(a) are satisfied.

Regarding item (2), the 37 CFR 1.47(a) applicant included an unsigned statement of facts of the actions taken by James L. Cordek in attempting to obtain the signature of the nonsigning inventor. The statement indicates that a copy of the patent application was sent on 19 July 2005. Mr. Cordeck phoned Mr. Katen on 01 August 2005 and the nonsigning inventor indicated that he would cooperate and "stated that he would sign the declaration and would return it to James I. Cordek." Mr. Cordek sent another copy of the application to the nonsigning inventor on 05 August 2005. Petitioners claim that no response has been received as of 15 August 2005. Petitioners included documentary evidence that the letters were delivered to the last known address of Mr. Katen and the documents contained a complete copy of the above-captioned application. However, this evidence is insufficient.

Section 409.03(d) of the MPEP discusses a refusal and states, in part:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. . . .

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted.

The time period between the phone call on 01 August 2005 and applicants' petition filed 15 August 2005 was too short for this conduct to constitute a refusal. The letter dated 05 August 2005 did not even list a deadline except "as soon as possible." Moreover, the statement of facts was unsigned.

Petitioners must provide a signed affidavit or declaration by Mr. Cordek listing the steps taken to contact Mr. Katen and any response received, if any. In addition, petitioners should indicate whether any further attempts to contact the nonsigning inventor has taken place to determine if Mr. Katen received the documents and has changed his mind on cooperating. If no attempt has been made, petitioners should explain why not.

For this reason, item (2) of 37 CFR 1.47(a) is not yet satisfied.

CONCLUSION

Applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. No additional petition fee is required.

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.


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